

REMARKS

The Final Office Action dated November 5, 2003 (Paper No. 19) and the Advisory Action dated February 24, 2004 have been considered.

Summary of the Final Office Action and the Advisory Action

In the Final Office Action, claims 1-2 and 4-5 remain rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,125,091 to Kasuga. Claim 3 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuga in view of U.S. Patent No. 5,619,521 to Tanaka.

In the Advisory Action, the Examiner refused entry of an after-final Amendment under 37 C.F.R. § 1.116 filed on January 28, 2004, indicating that the Amendment fails to place the application in condition for allowance. In particular, the Advisory Action states that the proposed amendments filed on January 28, 2004 are not deemed to place the application in better form by materially reducing or simplifying the issues for appeal.

Summary of the Response to the Office Action

Concurrent with the instant Request for Continued Examination ("RCE") filing, Applicants have added new independent claims 6 and 7 to differently describe the invention. Accordingly, claims 1-7 are currently pending for consideration.

Rejection under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1-2 and 4-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kasuga. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuga in view of Tanaka. These rejections are respectfully traversed as follows.

Applicants concede that Kasuga discloses two semiconductor lasers 4 and 5 arranged on a base 3 of an optical pickup apparatus 1, as shown in Fig. 1 of Kasuga. However, each of these

semiconductor lasers 4 and 5 is disclosed as a laser diode chip, which functions as a single light emitting portion, as also shown, for example, in Fig. 1 of Kasuga. It is respectfully submitted that it is well understood in the subject art that each of Kasuga's semiconductor laser diode chip packages 4 and 5 has its own respective substrate with its own respective light emitting portion formed thereon. Moreover, Applicants respectfully submit that each of Kasuga's semiconductor laser diode chip packages 4 and 5 respectively includes three connection terminals and a case covering the substrate and light emitting portion of the chip. See at least Fig. 1 of Kasuga.

Figs. 2 and 3 of the instant application show a semiconductor laser device chip 11 that includes a single substrate having first and second light emitting portions 21 and 22. Like the semiconductor laser diode chip of Kasuga, the chip 11 disclosed in the instant application also includes connection terminals and a case covering the chip materials.

Moreover, Applicants respectfully submit that independent claim 1 recites a "laser diode chip comprising: a substrate." It is well understood that this refers to a substrate contained within the package of the laser diode chip. Moreover, independent claim 4 recites "a light emitting device which has a substrate (emphasis added)." Accordingly, Applicants respectfully submit that Kasuga's base 3, which the Examiner interprets as the "substrate" recited in at least independent claims 1 and 4, does not correspond to the recited substrates of independent claims 1 and 4.

Moreover, it is clear from the definitions set forth in the instant application's specification, as explained at page 6, lines 10-21 of the Amendment previously filed in this application on September 22, 2003, that the "substrate" recited in claims 1 and 4 is a single substrate within a laser diode chip package that allows for a plurality of light emitting portions to be formed on the single substrate within a laser diode chip package.

Even further, independent claim 1 explicitly recites “a plurality of light emitting portions which are formed on said substrate.” Similarly, independent claim 4 explicitly recites “a plurality of light emitting portions ... are formed on said substrate.”

On the Continuation Sheet of the Advisory Action dated February 24, 2004, the Examiner correctly interprets reference numerals 4 and 5 of Kasuga’s Fig. 1 as “chips.” As noted above, the claims, together with the supporting disclosure of the instant application, clearly recite the concept of the substrate being included within these respective “chips.” Accordingly, Applicants respectfully submit that the base 3 of the entire optical pickup apparatus 1 shown in Fig. 1 of Kasuga clearly does not correspond to a substrate included within a laser diode chip package.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because Kasuga does not teach or suggest each feature of independent claims 1 and 4. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, Applicants respectfully assert that dependent claims 2 and 5 are allowable at least because of their respective dependence from independent claims 1 and 4, as amended, and the reasons set forth above.

The Office Action applies Tanaka as a secondary reference in combination with Kasuga in its rejection of claim 3 under 35 U.S.C. § 103(a). This combination rejection is respectfully traversed at least because Tanaka does not cure the deficiencies of Kasuga discussed above with regard to independent claim 1. MPEP § 2143.03 instructs that “[t]o establish prima facie

obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974)." Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

Newly-Added Claims 6 and 7 Also Distinguish over the Applied Art

In an after-final Amendment under 37 C.F.R. § 1.116 filed on January 28, 2004 in the instant application, Applicants presented proposed amendments to independent claims 1 and 4 to even further distinguish the claims of the instant application from the Kasuga arrangement.

In particular, Applicants had proposed to amend independent claim 1 to recite that "said laser diode chip is provided separate from ... the optical pickup apparatus." Moreover, Applicants had proposed to amend independent claim 4 to recite that "said light emitting device is provided separate from said optical system."

In an Advisory Action dated February 24, 2004, the Examiner refused entry of these proposed amendments, as presented in the Amendment under 37 C.F.R. § 1.116 filed on January 28, 2004, indicating that the Amendment fails to place the application in condition for allowance. In particular, Advisory Action stated that the proposed amendments are not deemed to place the application in better form by materially reducing or simplifying the issues for appeal.

On the Continuation Sheet (PTOL-303) to the Advisory Action, the Examiner noted that

"[t]he proposed amendment, in adding limitations drawn to the chip being separate from the guiding portions, does not in any way reduce or simplify the issues for appeal. Further, note that this proposed limitation does nothing to patentably distinguish from Kasuga; in Kasuga, the chips 4 and 5 are not the same as the guiding portions 21-24, and thus can be interpreted as separate. Merely saying that they are separate does not distinguish."

Applicants respectfully traverse the allegations set forth on the Continuation Sheet to the Advisory Action. For example, the proposed amendment to claim 1, as filed on January 28, 2004, recited that the “laser diode chip is provided separate from ... the optical pickup apparatus.” The laser diode chip is defined previously in the claim as including a substrate and a plurality of light emitting portions. Moreover, on the Continuation Sheet of the Advisory Action, the Examiner interprets reference numbers 4 and 5 of Kasuga as representing “chips.” As a result, it follows that the claim requires that the optical pickup apparatus is provided separately from the laser diode chip, including the substrate.

The Examiner’s statement on the Advisory Action’s Continuation Sheet that Kasuga’s chips 4 and 5 can be interpreted as separate from its guiding portions 21-24 does not address this point because the proposed claims did not merely recite that the optical system was separate from the “light emitting portions.” Instead, the proposed amendment to claim 1 recited that the optical system is separate from the entire “laser diode chip,” which includes the recited substrate. Similarly, the proposed amendment to claim 4 recited that the optical system is separate from the entire “light emitting device,” which also includes the recited substrate.

As set forth in detail in a previous Amendment filed on September 22, 2003 in this application, the Office Action cites to the base 3 of Kasuga as meeting the “substrate” limitations recited in independent claims 1 and 4. It is clear from Kasuga that its optical system portions, referred to by the Advisory Action as “guiding portions 21-24,” are disclosed as being “constructed on base 3.” See, for example, col. 3, lines 14-15 and Fig. 1 of Kasuga. Accordingly, Kasuga does not teach or suggest to any extent providing an optical system separately from a “substrate” in the manner recited by the proposed amendments to claims 1 and 4, at least because the Office Action itself interprets Kasuga’s base 3 as meeting the “substrate”

limitations of independent claims 1 and 4. This difference is also apparent from a simple comparison of the arrangement illustrated in Figs. 2 and 3 of the instant application with the arrangement illustrated in the applied Fig. 1 of Kasuga.

Accordingly, the amendments to independent claims 1 and 4 that were previously proposed in the Amendment under 37 C.F.R. § 1.116 filed on January 28, 2004, but which were not entered by the Examiner, are represented as newly-added claims 6 and 7 herein with additional recitations in light of the Examiner's comments in the Advisory Action. In particular, newly-added independent claim 6 recites that "said laser diode chip, including the substrate, is provided separate from the optical pickup apparatus (emphasis added)." Similarly, newly-added independent claim 7 recites that "said light emitting device, including the substrate, is provided separate from said optical system (emphasis added)." Accordingly, Applicants respectfully submit that newly-added claims 6 and 7 are also in condition for allowance over the applied art of record.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required,

including any required extension of time fees, or credit any overpayment to Deposit Account

50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR
EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

MORGAN, LEWIS & BOCKIUS LLP

Dated: April 5, 2004

By:



Paul A. Fournier

Reg. No. 41,023

Customer No. 009629

MORGAN, LEWIS & BOCKIUS LLP

1111 Pennsylvania Avenue, N.W.

Washington, DC 20004

Tel: 202-739-3000